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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,607	10/27/2003	Brian E. Le Gette	GRAY032/01US	6475

7590 07/27/2006  
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EXAMINER

SUTTON, ANDREW W

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/693,607

Applicant(s)

LE GETTE ET AL.

Examiner

Andrew W. Sutton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4/28/06.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-17 and 32-42 is/are pending in the application.
- 4a) Of the above claim(s) 32-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/11/05 &amp; 4/28/06</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 32-39 and 40-42 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

In the Office Action dated 12/28/05, Examiner detailed a restriction requirement between groups I-V. In response, Applicant elected group II, claims 9-17 drawn to an ear warmer including the length of the first portion of the ear portion and the length of the second portion of the ear portion in sum being at least half of the length of the ear portion. While Applicant also added new claims 32-42, they are drawn to new inventions insomuch as Claims 32-39 are drawn to an ear warmer frame with a first portion having a different radius of curvature than the second portion, and claims 40-42 are drawn to a an ear warmer including the second radius of curvature being greater than he first radius of curvature, which is not required in claims 9 or 32. As such, the invention of Group II has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 32-42 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Information Disclosure Statement***

The information disclosure statements filed 1/11/05 and 4/28/06 fail to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c)

most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

The references marked not considered were so due to no English language abstract given, reference not submitted, a copied material that is not legible, or not a valid publication number.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the recesses 2184 communicating with the second member of the band portion must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Applicant fails to disclose the first portion having a thickness greater than the second portion as in claim 12.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant claims a first and second portion of the ear. The applicant states in the specification a first end portion 2112 and second

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end portion 2116 on each ear portion. The applicant also states a first ear portion 2102 and a second ear portion 2104. The examiner cannot find reference to a first portion of the ear and a second portion of the ear as claimed in claim 1. It is unclear to the examiner which first and second portions the applicant is talking about. In light of the specification, the examiner assumes that the applicant is talking about the first and second end portions and the following action will be based upon that. Correction is needed.

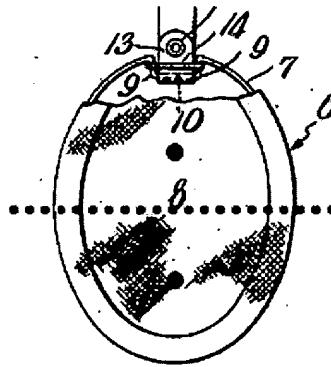
### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 16, and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Bean (US 2,149,383). Bean illustrates in Figs. 1-5 an ear warmer frame including a band portion 18 and an ear portion 7. The ear portion 7 is has an elliptical shape as shown below. Since the ear portion has an elliptical shape, it is inherent that the elliptical shape has two perpendicular axes as claimed. These two axes are shown as the dots above and below the dotted line. The line below divides the ear portion in half and shows the first portion (above the line) and a second portion (below the line) that are each curved around the first and second axes. Since there is no straight portion, to

break up the first and second portion, the examiner feels that the ear portion is made entirely of the first and second portion thus means the claimed limitations.



As to claim 10, Bean illustrates in Fig. 5 a band portion 17 including a first and second member, first member of the band portion has a first end portion and a second end portion, the second end portion of the first member is slidably coupled 20 to the second member of the band portion, the ear portion 5 coupled proximate to the first end portion of the first member of the band portion.

As to claim 11, Bean illustrates in Fig. 4 as shown above an ear portion 7 that tapers from the bottom of the first portion (at the dividing line) to the second portion (bottom half of the frame 7).

As to claim 14, Bean illustrates in Fig. 4 a projection 10 extending in the ear portion that includes a wire 9 located in the project.

As to claim 15, Bean illustrates in Fig. 5 the frame 6 being disposed within a shell 5.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bean (US 2,149,383). Bean discloses the device substantially above. However, Bean does not disclose the ear frame having a first portion thicker than the second portion. The applicant fails to disclose criticality or unexpected results from the various thicknesses being placed on the first and second portions, there for it would have been obvious to one of ordinary skill in the art to make the first portion thicker than the second portion as a design choice.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bean (US 2,149,383) in view of Bavetta (US 6,499,146). Bean teaches a band with two coupled members that are capable of sliding as discussed above. However Bean does not teach the use of a plurality of recesses to engage the first end of the second member. Bavetta illustrates (Fig. 4A) the use of a band including a first member 210 with an outer surface including a plurality of recesses to engage the second member 200. It would have been obvious to one of ordinary skill in the art to combine the teachings of Bean and Bavetta to provide a band with a more rigid connection.

### ***Conclusion***



The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Isom (US 6,978,483), Lundin (US 4,133,053), and Reinemer (US 2,120,189) teach the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew W. Sutton whose telephone number is (571) 272-6093. The examiner can normally be reached on Monday - Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary L. Welch can be reached on (571) 272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AWS  
6/21/06

  
**GARY L. WELCH**  
**PRIMARY EXAMINER**